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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,211	09/10/2003	Liane Redford	16222U-012710US	6545

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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08/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,211

Applicant(s)

REDFORD ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/29/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/10/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 5/29/2008.
2. Applicant elected Group I, consisting of claims 1-22.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6-8, 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Leonard et al. (5,903,874 hereinafter Leonard).

With respect to claims 1, 6-7 Leonard teaches a system or managing a coupon redemption under a reward program (Abstract). A token configured to store an electronic coupon and a redemption tally, the redemption tally representing the number of times the electronic coupon has been redeemed by a holder of the token for corresponding reward under the reward program (i.e. coupon files 322a-322n); a token acceptance device configured to store a redemption limit relating to the electronic coupon, the redemption limit representing the maximum number of times the electronic coupon is allowed to be redeemed for the corresponding reward under the reward program, the token acceptance device further configured to receive information relating to a transaction from the holder (i.e. servers 118 and 122); wherein the holder indicates

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to the token acceptance device that the electronic coupon is to be redeemed and applied to the transaction (i.e. the customer request to redeem the coupon)(see figure 7, 708); and wherein upon receiving indication of redemption of the electronic coupon, the token acceptance device compares the redemption limit to the redemption tally and determines whether the electronic coupon is allowed to be redeemed and applied to the transaction (see figure 7, 712).

With respect to claims 8, and 13-14, Leonard further teaches a reward host configured to store a redemption limit, the redemption limit representing the maximum number of times an electronic coupon is allowed to be redeemed for a reward under the reward program (Figure 1, 132).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5, 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Official Notice.

Claim 5 further recites wherein the token includes one of a smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security

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card, an access card, smart media and a transponder. Leonard teaches the token being an encrypted coupon, Leonard doesn't specifically teach the token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder. Official Notice is taken that token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder is old and well known in order to provide coupon mobility and easy access to the coupon information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder in order to obtain the above mentioned advantages.

Claims 15-18, 20-21, the claims differ from claim 1 rejected above in that the claims further recite retrieving a token image. Since, Leonard teaches an encrypted coupon then a coupon image would have been obvious in order to provide a visual imitation of the coupon. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included retrieving a token image in order to obtain the above mentioned advantage.

Claim 19 is similar to scope as claims 8 and 13-14 and therefore is rejected under similar rationale.

7. Claims 2-3, 9-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,336,099 hereinafter Barnett).

With respect to claims 2-3 and 9-10, Leonard teaches a reward host (i.e. Data Distribution System (DDS) 132) which receives new promotion and coupon information limits. Leonard is silent as to receiving the coupon information from a reward program sponsor. Barnett teaches on Figure 1 receiving discount and redemption information from an entity issuing the coupons such as a retailer, vendor, manufacturer etc. It would have been obvious in the system of Leonard for the Data Distribution System (DDS) 132 to have received the information from a vendor, merchant, etc. in order to accomodate a variety of reward programs that comply with the different entities sponsoring the programs.

Claims 4 and 11 further recite the redemption limit is established based on one or more criteria that are specific to the holder of the token. Leonard teaches limiting the redemption limit (Figures 10-12). Leonard doesn't specifically teach that the coupon limit is based on the specific holder's criteria. Barnett teaches using the coupon based on the user specific data (see Figure 2, 30d). It would have been obvious in the redemption limit of Leonard to have included specific holder/customer criteria because such a limitation would allow the coupon limit to be customized based on the user's needs.

Claim 12 further recites wherein the token includes one of a smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder. Leonard teaches the token being an encrypted coupon, Leonard doesn't specifically teach the token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder. Official Notice is taken that token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder are all well known devices used to provide coupon mobility and easy access to the coupon information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the token/coupon being one of smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder in order to obtain the above mentioned advantages.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
8/5/2008

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